

U.S. Application No. 09/672,328
Amendment dated February 23, 2004
Reply to Office Action dated October 22, 2003

REMARKS/ARGUMENTS

Reconsideration and continued examination of the above-identified application are respectfully requested.

The amendment to the claims further defines what the applicant regards as the invention. Full support for the amendment can be found throughout the specification and in the claims as originally filed, for instance, at pages 12, 13, and claim 28 of the present application. Therefore, no new questions of patentability should arise nor does the amendment necessitate any further searching on the part of the Examiner. The amendment places the application in condition for allowance. At a minimum, the amendment places the application in a better condition for appeal. Accordingly, no questions of new matter should arise and entry of the amendment is respectfully requested.

Further, claims 3-31 were only objected to. The subject matter of claim 28 is now present in claim 1. Therefore, all claims should be allowable.

Claims 1-27 and 29-31 are pending in the application. Claim 28 has been cancelled.

At page 2 of the Office Action, the Examiner maintains the rejection of claim 1 under 35 U.S.C. §112, first paragraph. The Examiner states that the specification is enabling for pigments such as blue, black, white, brown, cyan, green, violet, magenta, red, yellow, and mixtures thereof, anthraquinones, phthalocyanine blues, phthalocyanine greens, diazos, monoazos, pyranthrone, perylenes, heterocyclic yellows, quinacridones, and (thio) indigoids. However, the Examiner asserts that these pigments do not reasonably provide enablement for all of the pigments in the chemical field. Furthermore, the Examiner asserts

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that the specification fails to provide information that would allow one skilled in the art to practice the claimed invention without undue experimentation.

The Examiner also asserts that the specification of the present application provides only particular examples to represent the modified pigments of the claimed invention. According to the Examiner, those examples are not exemplary of the entire scope of modified pigments. Thus, the Examiner concludes that the specification of the present application fails to provide sufficient working examples to support the claimed modified pigments and the method of making them.

The Examiner further states that while the specification is enabling for one organic ionic group, such as $C_6H_4CO_2$, $C_6H_4SO_3$, $C_{10}H_6CO_2$, $C_{10}H_6SO_3$, $C_2H_4SO_3$, etc., the specification does not reasonably provide enablement for all of the organic ionic groups in the chemical field.

Furthermore, the Examiner asserts that while the specification is enabling as to one amphiphilic counterion group, such as cationic amphiphilic ions and anionic amphiphilic ions, the specification does not reasonably provide enablement for all of the amphiphilic counterion groups in the chemical field. Therefore, the Examiner requests that the scope of the amphiphilic counterion groups be limited to the amphiphilic counterion groups specifically listed in the specification. For the following reasons, this rejection is respectfully traversed.

With respect to the term "pigment," claim 1 of the present application specifically recites a list of pigments that can be used in the claimed invention. Accordingly, the term "pigment" in claim 1 of the present application is enabled.

With respect to the Examiner's argument that the scope of the organic ionic group of

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the claimed invention should be limited to the organic ionic groups specifically listed in the specification, the applicant respectfully disagrees. Again, the Examiner has provided no technical reasons or prior art to support the argument that the present specification does not provide enablement to one skilled in the art. The Examiner has the initial burden to provide some technical foundation for arguing that the present specification does not provide enablement to one skilled in the art, and that burden has not been met. Merely asserting that the present application should be limited to the specific, literally recited groups set forth in the specification is not sufficient grounds for an enablement rejection. The Examiner must set forth technical reasons why enablement is not satisfied in view of the skill possessed by one skilled in the art and in view of the technical disclosure provided by the present application. The present specification clearly provides a detailed listing of various organic groups that can be used as well as methods to attach organic groups onto a pigment. Furthermore, specific examples are provided showing the attachment of organic groups. For instance, the specification , at page 9, line 20 - page 10, line 18, provides a sufficiently clear explanation of the chemistry to enable a person having ordinary skill in the art to make and use the invention without undue experimentation.

As stated earlier under *United States v. Teletronics, Inc.*, if only one species of an invention is provided, but sufficient information exists to produce the other species without undue experimentation, the enablement requirement for the generic claim is satisfied. The present invention provides much more than one species. In addition, there is sufficient information provided throughout the specification to produce other species. Since the Examiner provides no technical support at all that undue experimentation would be required, the Examiner's statement is conclusory in nature, and this part of the rejection should be

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withdrawn.

With respect to the Examiner's request to limit the scope of the amphiphilic counterion groups of the claimed invention to the amphiphilic counterion groups specifically listed in the specification, the applicant respectfully disagrees. Again, the Examiner has provided no technical reasons or prior art to support the argument that the present specification does not provide enablement to one skilled in the art. The Examiner has the initial burden to provide some technical foundation for asserting that the present specification does not provide enablement to one skilled in the art, and that burden has not been met. Merely asserting that the present application should be limited to the specific recited groups set forth in the specification, is not sufficient grounds for an enablement rejection. The Examiner must set forth technical reasons why enablement is not satisfied in view of the skill possessed by one skilled in the art and in view of the technical disclosure provided by the present application. The present specification clearly provides a detailed listing of various amphiphilic counterionic groups that can be used as well as methods to attach amphiphilic counterionic groups to a pigment. Specific examples are also provided showing the attachment of these groups. Moreover, the specification, at page 11, line 7 - page 13, line 10, provides a sufficiently clear explanation of the amphiphilic counterion groups to enable a person having ordinary skill in the art to make and use the claimed invention without undue experimentation. Accordingly, one skilled in the art would be clearly able to attach a variety of amphiphilic counterionic groups onto the pigment as set forth in the claims of the present application. Absent the Examiner providing clear technical support, this rejection should be removed, since the Examiner's statement is conclusory.

Moreover, the one patent relied upon by the Examiner in the previous Office Action

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dated March 12, 2003, U.S. Patent No. 5,698,016 to Adams et al., specifically refers to and claims organic groups and amphiphilic ions. Clearly, these terms have been recognized in the past and the type of disclosure for these terms as set forth in Adams et al. is no different from the type of support provided in the present application. Also, this patent supports the position that sufficient support and enablement exist in the present application. Accordingly, the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

At page 2 of the Office Action, the Examiner rejects claim 2 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. More specifically, the Examiner asserts that the word "type" in the phrase "one type of non-ionic group" is unspecified as to what type of non-ionic group might be involved in the modified pigment. For the following reasons, this rejection is respectfully traversed.

Claim 2 of the present application now recites, in part, at least one non-ionic group. The scope of the claim remains the same. Accordingly, this rejection should be withdrawn.

At page 3 of the Office Action, the Examiner indicates that the rejection of claims 1-4, 6, 7, and 20-31 under 35 U.S.C. §103(a) as being unpatentable over Adams et al. (U.S. Patent No. 5,698,016) in view of Kato et al. (U.S. Patent No. 5,731,115) has been withdrawn. Additionally, the Examiner indicates that claims 3-31 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The applicant and the undersigned appreciate the Examiner's indication that these claims would be allowable. Since claim 28 has been incorporated into claim 1, all claims should be allowable.

The Examiner is respectfully requested to contact the undersigned by telephone

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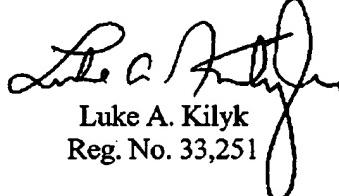
should there be any remaining questions as to the patentability of the pending claims.

CONCLUSION

In view of the foregoing remarks, the applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims.

If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 03-0060. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



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